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Attorney's Docket No.: 09464-010001

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Applicant : Marco Zuniga et al.
Serial No. : 09/475,713
Filed : December 30, 1999
Title : SWITCHING REGULATOR WITH MULTIPLE POWER TRANSISTOR DRIVING VOLTAGES

Art Unit : 2838
Examiner : Shawn Riley

BOX AF
Commissioner for Patents
Washington, D.C. 20231

PETITION UNDER 37 CFR 1.144

In response to the Advisory Action mailed June 5, 2001, Applicant petitions the Commissioner under 37 CFR 1.144 to review the restriction requirement.

Reconsideration of the requirement was requested in the response filed August 8, 2000.

The issue presented is relatively straightforward; whether two claimed inventions are used together or are independent. In essence, the Examiner's position is that "used together" must mean that every element of the first claim is encapsulated in one part of an embodiment, and every element of the second claim is encapsulated in another part of the same embodiment. In contrast, Applicants maintain that "used together" merely requires that the elements of both claims be present in the embodiment.

I. Background

The Examiner has imposed a restriction on the basis that the inventions are unrelated. Inventions are unrelated only if they are disclosed as not being useable together. Inventions are not usable together if they are different combinations not disclosed as capable of use together (e.g., a shoe and a locomotive bearing), if one is a process and another is an apparatus that cannot

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be used to practice the process, or if they are mutually exclusive species (e.g., paper clips varying in how a section of wire is formed). See MPEP 806.04(A)-(C).

The Examiner indicated in a telephone conference that that he was relying on MPEP 806.04(A), i.e., that the inventions were different combinations not disclosed as capable of use together. First, as shown by the example of a shoe and a locomotive bearing, MPEP 806.04(A) is intended for use when the inventions are in completely separate technologies. Second, the MPEP notes that "This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things." See MPEP 808.01. In other words, the MPEP itself recognizes that the situation of MPEP 806.04(A) is "rarely presented".

The Examiner has noted that the inventions would require separate searches. However, the fact that inventions have different classifications is not evidence of independence. For example, a product and a process of using are often in different classifications, yet they are clearly related. See MPEP 806.05(f). Instead, separate classification is a reason to apply a restriction when the inventions are related but distinct. See MPEP 808.02.

II. The Examiner's Characterization of Single versus Multiple Transistor Regulators

The Examiner notes in the Advisory Action that "one regulator functions and is designed completely differently than the second". In the Advisory Action of July 2, 2001, the Examiner again states, "the first and second regulators are different, require different modes for functioning and are not used together."

Applicants disagree with the Examiner's technical characterization. **To provide a regulator with a single transistor, the second transistor 42 may simply be replaced by a diode** (see Applicants' specification page 4, lines 18-19). This results in a voltage regulator with a single transistor that is designed and functions almost identically to a voltage regulator with two transistors, with the difference merely that only one control signal is needed rather than two.

III. Legal Standard

Even if the Examiner's technical characterization was accurate, the Examiner applies incorrect law.

The Examiner states, "in no part of the disclosure is there mention of both regulators being used together at the same time". However, the requirement is not that two different regulators be usable together, but that the claimed inventions be disclosed as usable together.

Claim 1 calls for a voltage regulator that has a first transistor [A], a second transistor [B], a filter [C], and a controller [D], and that the first and second transistors have a gate oxide and are driven with different gate voltages [E].

Claim 11 calls for a voltage regulator with a transistor [A] and a filter [C], in which the transistor has a channel length which is less than a channel length required for reliable behavior [F].

The Examiner's position is that "useable together" means the specification must show two separate voltage regulators (corresponding to the structures recited in claims 1 and 11) being used together, i.e., ABCDE + ACF.

In contrast, Applicant argues that "useable together" means the specification must show a single embodiment that includes all of elements, i.e., ABCDEF.

In this case, the claimed inventions clearly are related as subcombinations usable together. A combination is an organization of which a subcombination or element is a part. MPEP 806.05(a).

The implementation of Figure 4 is the combination: it has a first transistor [A], a second transistor [B], a filter [C], and a controller [D], with the first and second transistors having a gate oxide and being driven with different gate voltages [E], and with the first transistor having a channel length which is less than a channel length required for reliable behavior [F]. Claim 1 is the subcombination ABCDE, whereas claim 11 is the subcombination ACF. Thus, these two subcombinations are part of a single combination.

In short, since all of the limitations of both claims 1 and 11 can be found in the embodiment shown by Figure 4 (see Figure 4, page 8, lines 24-26 and page 9, lines 13-14), the inventions have been used together, and are therefore related.

This situation is analogous to the Examiner arguing that if claim 1 calls for a car with a novel brake and claim 2 calls for a car with a novel steering wheel, then claims 1 and 2 are unrelated because two cars cannot be used together. This is simply the wrong analysis - if the

novel steering wheel and the novel brake can both be used in the same car, then the claimed inventions can be used together.

The Examiner argues that the situation is more analogous to the steering wheel of an airplane (with control in three dimensions) and a steering wheel of a car (with control in two dimensions). However, the Examiner's rebuttal remains improper. Since claims are open-ended, a claim that recited a vehicle with a steering wheel that controls in two dimensions would also read on a vehicle with a steering wheel that controls in three dimensions. Similarly, a claim that calls for a voltage regulator with a transistor would read on a voltage regulator with more than one transistor.

Since the Examiner's holding could affect the interpretation of claims 11-14 in a continuation application, this petition is needed to settle the proper application of the law.

Applicants request that the restriction on the basis of independence be withdrawn.

Enclosed is a check for the petition fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 7/23/01

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